



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,298	09/15/1999	JEFFREY M. HARRINGTON	4965.00	8579

25227 7590 12/03/2003  
MORRISON & FOERSTER LLP  
1650 TYSONS BOULEVARD  
SUITE 300  
MCLEAN, VA 22102

EXAMINER
----------

HUYNH, THU V

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 12/03/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/397,298

Applicant(s)

HARRINGTON, JEFFREY M.

Examiner

Thu V Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 23-127 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is responsive to communications: Request for consideration filed on 09/08/2003 to application filed on 09/15/1999.
2. Claims 1-21 and 23-127 are pending in the case. Claims 1, 17, 71, 85, 94, 98, 109, and 115 are independent claims.
3. Claims 1-21 and 23-70 were selected to examination.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-13, 15-21, 23-29, and 31-70 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary et al., US 5,774,664 -filing date 3/25/1996, in view of O'Brien et al., US 6,055,569 -filing date 1/27/1998.**

**Regarding independent claims 1 and 17,** Hidary teaches receiving an instruction to retrieve a web page using an address and further retrieving the information. URLs and web browsers are used to retrieve the information, which is then shown on a display (col 3, lines 26-38; compare with "A method... using the address; "). Hidary teaches displaying the page based on particular criteria as indicated by being displayed at a particular time (col 3, lines 32-37; compare with "commanding... criteria. ").

Hidary does not explicitly disclose constructing the web pages prior to display on a display device. However, O'Brien does disclose downloading pages and storing them in a memory cache (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Hidary and O'Brien. This would have improved the supplemental data's display speed by preparing web pages ahead of time. This would be especially useful to users who may have slower network connections.

**Regarding dependent claims 2, 5, 6, 18 and 21,** Hidary teaches receiving timer event information that indicates when a web page is displayed when web pages are shown at appropriate times (col 3, lines 32-37) and when URLs are scheduled to be transmitted to a user (col 3, lines 42-52). Hidary does not explicitly disclose trigger event information being downloaded and the web page being generated on the trigger. He does, however, disclose the aforementioned scheduling. When specific times of the day occur, appropriate information is sent and received. This time event driven action is comparable to the claimed time expiration actuator.

**Regarding dependent claims 3 and 19,** Hidary teaches utilizes timing information to indicate when URLs are to be transmitted and subsequently displayed (col 3, lines 42-52). The invention sends a command for the retrieval and subsequent display of a web page when the scheduled time is reached.

**Regarding dependent claims 4 and 20**, Hidary teaches addresses comprising URI.s (col 3, lines 29-30).

**Regarding dependent claims 7 and 23**, as per the rejection of claim 1, O'Brien teaches downloading and storing a web page in a memory cache.

**Regarding dependent claims 8 and 24**, Hidary teaches a web browser retrieving web page information (col. 3, lines 30-32).

**Regarding dependent claims 9-13 and 25-29**, Hidary teaches embedding addresses, which instruct a web page to be displayed, in a video program (col.3, lines 25-32 and col 4, lines 3035). Hidary discloses displaying both the web page and video simultaneously (col.3, lines 30-37), displaying them on a computer monitor or television set, and displaying each on a different display apparatus (col.8, lines 45-52).

**Regarding dependent claims 15 and 31**, Hidary teaches implementing his invention in networks including the Internet, private networks, and wireless networks (col 6, lines 39-41). He also teaches the delivery of program data in which the addresses are embedded via any transmission means, including satellite, cable, wire, or television broadcast (col 4, lines 35-39).

It was known and typical in the art at the time of the invention for PCs, TVs, cable boxes, satellite boxes, radios, telephones, answering machines, wireless phones, wireless Internet devices, telephony devices for the deaf, and PDAs to all be common devices for receiving and

Art Unit: 2178

sending signals using the transmission means disclosed by Hidary. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Hidary's invention in the listed devices. This would have fully utilized the invention's ability to be implemented in various transmission situations and would have allowed users limited to specific devices to use the invention.

**Regarding dependent claims 16 and 32,** Hidary teaches his invention as enabling advertisers to directly send their Web advertisements to users (col 2, lines 24-65). Hidary also disclose on-line systems as offering a variety of content, including news, games, job services. and more (col 1, lines 21-28). It was known and typical in the art at the time of the invention for on-line systems such as the Internet to provide a plethora of content.

**Regarding dependent claims 33-35,** these claims fully incorporate the rejection of claim 1. O'Brien discloses downloading a plurality of pages predicted most likely to be selected and storing them in a memory cache (abstract).

**Regarding dependent claims 36 and 43,** Hidary discloses retrieving a page due to a URL delivered in a program that is sent as a data stream (col 3, lines. 25-40).

**Regarding dependent claims 37 and 44,** Hidary teaches implementing his invention in networks including the Internet, private networks, and wireless networks (col 6, lines 39-41). He

Art Unit: 2178

also teaches the delivery of program data in which the addresses are embedded via any transmission means, including satellite, cable, wire, or television broadcast (col 4, lines 35-39).

**Regarding dependent claims 38 and 45**, Hidary teaches presenting a user interface to user that can be used to control retrieving instructions (col 5, lines 47-64).

**Regarding dependent claims 39 and 45, 41 and 48**, the claims incorporate substantially similar subject matter as claims 11 and 13, respectively, and are rejected along the same rationale.

**Regarding dependent claims 40, 42, 47, and 49**, Hidary discloses synchronizing the display of the program and web page (abstract).

**Regarding dependent claim 50-51**, the claims incorporate substantially similar subject matter as claims 12 and 15, and are rejected along the same rationale.

27. Regarding dependent claims 52 and 54, the claims incorporate substantially similar subject matter as claim 10, and are rejected along the same rationale.

**Regarding dependent claims 53 and 55**, Hidary teaches receiving video programming in different manner (col 4, lines 36-39) and from a plurality of sources (col 5, lines 9-12).

29. Regarding dependent claims 56-57, Hidary teaches embedding instructions in a plurality of ways (col 4, lines 40-56).

**Regarding dependent claims 58 and 60**, Hidary discloses videos containing retrieving instructions residing on servers (col 5, lines 1-6).

**Regarding dependent claims 59 and 61**, the claims incorporate substantially similar subject matter as claim 15, and are rejected along the same rationale.

**Regarding dependent claims 62-70**, Hidary teaches displaying web page addresses on the display and saving a plurality of addresses in a list for future display (col 7, lines 66 - col 8, lines 17).

**Regarding dependent claims 59**, the claim incorporates substantially similar subject matter as claim 15 and is rejected along the same rationale.

**6. Claims 14 and 30 remain rejected under 35 U.S. C. 103(x) as being unpatentable over Hidary in view of O'Brien and in further view of Butler et al (herein Butler; UK Patent App. GB 2327837A -publication date 2/3/1999).**

**Regarding dependent claim 14 and 30**, Hidary does not explicitly disclose the web page being overlayed on the program. However, Butler discloses an invention that broadcasts a video stream and accompanying supplemental data in which the data comprises an HTML file with instructions for a hyperlink overlay on the video stream. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hidary and



Butler. This would have provided further customization of the video stream by meshing the web page and the video together, providing a user with one area in which to focus instead of two.

***Response to Arguments***

7. Applicant's arguments filed 09/08/2003 have been fully considered but they are not persuasive.

Applicants argue that no teaching or suggestion in O'Brien of constructing a web page prior to display it. Applicants further argue that the combination of Hidary's and O'Brien's are unworkable.

These are not persuasive. Hidary inherently teaches a completely constructed page that is to be displayed on a client browser have all elements readily constructed (Hidary, col.3 lines 25-35 and col.4 lines 30-35). Hidary further teaches that software modules can reside on the client side or server side where the URL codes are to be interpreted and their contents assembled (or constructed) (Hidary, col.5 line 25-46). O'Brien's teachings further show how to get all page elements (otherwise called contents), including the page itself ready to display.

As pointed out above, Hidary's teachings indicate software modules can reside on the client and/or server side. Hidary also specifically mentions these modules include a URL decoder and that URL codes is to subsequently be delivered to the user over the Internet to the user device. This strongly suggests the use of pre-fetching and/or caching of pages' contents. This is exactly what O'Brien teaches as applicants admit that "O'Brien teaches ... caching elements of a web page and assembling them when a user clicks a link or choose to view a page" (applicants' argument, page 3, lines 6-8). It would have been obvious to one of ordinary skill in

Art Unit: 2178

the art at the time of the invention to combine O'Brien into Hidary to construct and retrieve all contents prior to display.

It is noted that a web page must be constructed (statically or dynamically) in order to display the web page content, otherwise there would be nothing to display.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is 703-305-9774. The examiner can normally be reached on Monday, Tuesday and Thursday.

Art Unit: 2178

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

TVH  
November 29, 2003



STEPHEN C. [unclear]  
PRIMARY EXAMINER